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Signature of Sender:

Name of Sender:

HEIKE FRENDENMANN

PATENT

#### IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: LAUK

Application No.:

08/981,924

PCT No.:

PCT/DE96/01269

Int. Filing date:

12<sup>th</sup> July, 1996

Priority date:

12<sup>th</sup> July, 1995

Attorney docket No.:

P2941 WO US

FOR: METHOD FOR DETERMINING THE EFFECTIVENESS AND TOLERANCE

OF A XENOGENIC SUBSTANCE ADMINISTERED TO AN ORGANISM.

## TRANSMITTAL LETTER FOR REQUEST FOR RECONSIDERATION OF RENEWED PETITION

Assistant Commissioner for Patents Washington, D.C. 20231 U.S.A.

#### Dear Sir:

Transmitted herewith is a request for reconsideration of a pending petition.

- (X) No additional fee is required.
- ( ) The fee has been calculated as shown below:

- ( ) A Petition for Extension of time under 37 CFR 1.136(a)
- ( ) Please charge Deposit Account Number 50-0355 in the amount of \$ for the Petition.
- (X) The Commissioner is hereby authorized to charge payment of fees associated with this communication or credit any overpayment to Deposit Account Number 50-0355.
- (X) Applicant believes that no extension of term is required, beyond that petitioned for. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for an additional petition and fee for additional extension of time.
- () Power of Attorney.

Respectfully submitted,

Dr. Paul J. Vincent Reg. No. 37,461

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Fax: +49-711-299 594

#### In the United States Patent and Trademark Office

In re Application of: LAUK

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PCT No.: PCT/DE96/01269

Int. Filing date: 12th July, 1996

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FOR: METHOD FOR DETERMINING THE EFFECTIVENESS AND TOLERANCE

OF A XENOGENIC SUBSTANCE ADMINISTERED TO AN ORGANISM.

# Request for Reconsideration of Decision on Renewed Petition under 37 C.F.R. 1.137(a).

This communication is in response to the decision in the subject petition dated November 12<sup>th</sup>, 1999.

The pending petition in the subject request for PCT nationalization has been dismissed without prejudice, since there was no evidence provided that the Federal Express invoice corresponds to the 35 USC 371 application papers received by the PTO on 13th January, 1998 and assigned application number 08/981,924, wherein the applicant has not proved that the basic national fee was forwarded from Germany to the PTO on the 8th of January, 1998. The petition was also dismissed without prejudice, since the standard delivery time from Germany to the United States was 2 business days and since the papers were allegedly deposited on Thursday the 8th of January, 1998, two working days prior to the deadline, the papers would normally have arrived on Monday the 12th of January, 1998 which is the last day of the 30 month period

for submitting the basic national fee. A one day mailing or shipping delay can not be considered as unexpected, unforeseen or as an imperfection in the delivery service and the shipment of a package on the last possible day which would ensure its timely delivery is less than the care or diligence generally used and observed by careful men in their most important business.

In response to this decision, the applicant would like to submit further evidence and argumentation regarding the grounds for the decision. The applicant would like to subdivide discussion into two separate topics: 1) the issue of a correlation between the papers mailed by Federal Express as evidenced by the invoice and the subject application papers, and 2) the issue of due care and diligence.

1) With regard to the question of the correlation between the Federal Express invoice and the request for nationalization, the agent for the applicant would like to submit the following argumentation, facts and evidence. The Federal Express invoice indicates that a Federal Express mailing was dispatched on January 8<sup>th</sup>, 1998 from the Law Offices of Schuster & Partner to Box PCT USPTO. The Federal Express invoice also indicates that this mailing was delivered on January 13<sup>th</sup>, 1998 to the USPTO. There is no question that a request for nationalization in the subject petition application was made on January 13<sup>th</sup>, 1998. Therefore the date of delivery indicated on the Federal Express invoice correlates with the actual filing date of the subject request

for nationalization. The only remaining issue is whether or not the papers which were actually received on the 13<sup>th</sup> of January, 1998 correspond to the papers sent on January 8<sup>th</sup>, 1998 as evidence by the Federal Express invoice. This is clearly the case for the following reasons.

If the request for nationalization did not correspond to the Federal Express invoice then what possible contents could this Federal Express mailing have had? The only possibility could be that this Federal Express mailing corresponds to another mailing in another application pending before the USPTO involving the PCT office. This is referred to below as the alleged second mailing. Should such an alleged second mailing have been made, then there must have been two submissions to the USPTO Box PCT on Tuesday January 13th, 1998, one corresponding to the subject request for nationalization and a second corresponding to the alleged second mailing. However, since the time of delivery for Federal Express is two business days, assuming that the Federal Express invoice corresponds to an alleged second mailing, then the request for nationalization received by the USPTO, which the applicant represents was also sent by Federal Express, would have had to have been dispatched by Federal Express either on Thursday January, 8th or Friday January 9th, 1998 to have been received at the USPTO on January 13th, 1998. Under this scenario there would have been two mailings, one on January 8th, 1998 corresponding to the Federal Express invoice and a second mailing on either January 8th, 1998 or January 9th, 1998, also by Federal

Express, which corresponded to the received papers of the subject petition. However this scenario can not be true, since the Federal Express invoice shows one mailing only. In particular, the invoice of record is dated January 13<sup>th</sup>, 1998. Should there have been two mailings, on January 8<sup>th</sup>, 1998 and/or January 9<sup>th</sup>, 1998, then Federal Express would certainly have invoiced both of these mailings together. An examination of the invoice which has been submitted with the renewed petition shows however only one single entry. Moreover, no Courier Service other than Federal Express has ever been used by the agent for the applicant in his activities before the United States Patent and Trademark Office, when acting directly from Germany.

Assuming nevertheless an alleged second mailing, this alleged second mailing could only correspond to a communication to the USPTO in a parallel PCT nationalization application. The agent for the applicant began activities as counsel with the Law Offices of Schuster & Partner in October 1997. Prior to this time, the agent for the applicant had only been working with the Law Offices of Kohler, Schmid & Partner, also in Stuttgart. The first work in connection with Schuster & Partner was initiated with a request for nationalization of PCT/DE96/00866, assigned serial number 08/952,242 and filed at the USPTO on November 14<sup>th</sup>, 1997, applicant Wendler and attorney docket number P2909 WO US. A second filing involving the Law Offices of Schuster & Partner was an application due to Schill, attorney docket number P2915 WO US, which was a request for nationalization of PCT/DE96/00852, assigned US

serial number 08/952,241, also filed on November 14th, 1997. The third case involving work with Schuster & Partner with the agent for the applicant is the subject request for nationalization of this petition. A fourth case during this time period was a PCT nationalization request for an invention due to Honecker, attorney docket number PCT 2961, involving a request for nationalization of PCT/DE96/00852, assigned US serial number 09/000,054 and filed on January 22nd, 1998. There were no other pending applications filed by the agent for the applicant from the Law Offices of Schuster & Partner during this period of time. The Wendler and Schill applications were properly filed and there were no open deadlines regarding notices to file missing parts or the like. The Federal Express invoice of the subject petition cannot correspond to the Honecker application, since the Honecker application was filed on January 22<sup>nd</sup>, 1998. Therefore, there was in fact only one Federal Express mailing to the USPTO from Schuster & Partner on January 8th, 1998 and/or January 9th and that Federal Express mailing corresponded to the request for nationalization of the subject petition. Although other possible interpretations of the Federal Express invoice are conceivable, such interpretations are highly unlikely and are not reasonable. Request for reconsideration on this point is hereby made.

To provide evidence in support of the above mentioned statements regarding the issue of the correlation between the Federal Express invoice and the subject request for nationalization petition therefor, the applicant submits

Annexes A, B1 and B2. Annex A contains a list of final deadlines noted by the Law Offices of Schuster & Partner during the period of time during which preparations for the request for nationalization of the subject petitioned application were being made, extending from of December 21st 1997 to the 15th of February 1998. The entry for the subject petition application is indicated as docket number P2941 US due to LAUK and designated as a 30 month national phase deadline for the USA. The deadline of the 12th of January 1998 is properly noted. The only other PCT entry for the United States on this list is PCT 2961 due to HONECKER with the associated deadline of the 27th of January 1998 for the 30 month nationalization phase. Since this list contains all deadlines, including deadlines to respond to possible pending actions before the USPTO PCT office and since this list contains no entries corresponding to an alleged second mailing it is clear that there was no need for the applicant to submit an alleged second mailing on January 8th and/or 9th, 1998.

Turning to Annexes B1, B2, these annexes represent a Federal Express invoice received by the agent for the applicant in connection with his counsel activities for Kohler, Schmid & Partner. The Annexes B1 and B2 show that is general practice for Federal Express to issue multiple invoices involving a plurality of entries within several days of another. This provides evidence that no alleged second mailing occurred, since the invoice submitted in support of this petition shows only one invoiced entry.

Taken together these statements, arguments and evidence provide a clear and convincing indication that the most reasonable explanation for the Federal Express invoice submitted in support of this petition is that this invoice corresponds to the request for nationalization of the subject PCT application. Request for reconsideration is hereby made.

2) With regard to the second issue of due care, the agent for the applicant would like to make the following statements. As already mentioned above, the agent for the applicant began activities for the law offices of Schuster & Partner in November 1997. Two previous requests for PCT nationalization is had been made, both successful. The person carrying out the actual mailing work and noting the deadlines was Miss Nicole Strohmenge. The agent for the applicant worked closely with Miss Strohmenge and explained all necessary procedures for carrying out the nationalizing requests. The agent for the applicant was very pleased with the work of Miss Strohmenge and had complete confidence in her abilities. It later turned out that this confidence was not properly warranted.

On December 15<sup>th</sup>, 1997 Miss Strohmenge sent a declaration to the inventor for signature in the request for nationalization of the subject petition. On December 18<sup>th</sup>, 1997 the agent for the applicant reviewed all papers associated with the request for nationalization of the subject petition with Miss Strohmenge and signed a check dated December 18<sup>th</sup>, 1997 for

the fees in this application. On December 19th, 1997 the signed declaration was received in the morning mail at the Law Offices of Schuster & Partner. At this point of time, the application was complete for filing. However, on December 19th, 1997 Miss Strohmenge had a vacation day for carrying out a personal change of residence. On Monday December 22nd and Tuesday December 23rd Miss Strohmenge was on vacation. On Wednesday December 24th, and December 25th through December 28th, the Law Offices of Schuster & Partner were closed for Christmas vacation and over the weekend. On Monday December 29th, 1997 Miss Strohmenge returned to the Law Offices of Schuster & Partner but left early due to sickness. Miss Strohmenge returned to work on Tuesday December 30th, 1997 and worked a normal work day. On Wednesday December 31st, 1997 through January 6th, 1998 the Law Offices of Schuster & Partner were closed. On Wednesday January 7th, 1998 through Monday the 12th of January 1998, Miss Strohmenge simply failed to show up for work. She did not call and had no phone and since her residence had been changed, no one in the Law Offices knew where she was or how to contact her. As a result of this, her position with Schuster & Partner was terminated shortly thereafter.

During this entire period of time, the calendar of deadlines which had been kept by Miss Strohmenge was not reviewed by any other persons, since Miss Strohmenge was responsible for all of her deadlines and since it was normal Office Policy that the person keeping the respective calendar must either observe the deadline or notify a colleague. In particular,

since the application papers for nationalization were ready for filing on the 19th of December 1997 and the actual deadline for nationalization was the 12th of January 1998, there appeared to be a sufficient amount of time for filing the application, even under the circumstances. In particular, Miss Strohmenge could easily have filed the papers on the 29th of December 1997 or certainly at the latest on the 30th of December 1997. Moreover, had Miss Strohmenge notified the Law Offices of Schuster & Partner on the 7th of January 1998 that she was not coming to work, her calendar would have been checked by another paralegal assistant and the request for nationalization could have been dispatched one day earlier.

On January 8<sup>th</sup>, 1998 Heike Freudenmann discovered, through a routine check of the calendar of Miss Strohmenge, that the deadline for nationalization of the subject application had not yet been observed. She immediately dispatched the papers via Federal Express.

Ironically, despite the series of events, the papers would normally have been received by the USPTO in time for the nationalization deadline. The mailing would have normally been flown from Germany on Friday, January 9th and should have been received in the Washington D.C. area on late Friday afternoon January 9th, 1998. The papers would normally be ready for delivery on the next day on which the USPTO has opened, namely Monday January 12th. Therefore, due care was in fact taken on the part of the agent for the applicant but through a series of unusual circumstances, sickness, and

unexpected irresponsibility on the part of the paralegal assistant responsible for the case, the deadline was not met.

In support of the above statements, the agent for the applicant submits the following evidence. In particular Annex C is a true copy of a check written out and signed by the agent for the applicant in the subject request for nationalization. The check is dated December 18<sup>th</sup>, 1997 and shows the attorney docket number P2941WO US as well as the PCT serial number PCT/DE96/01296. The request for nationalization fee is included. This check provides evidence that the application was ready for mailing on or about December 18<sup>th</sup>, 1997. Annex D is a calendar indicating the vacation and sick days for the employees of Schuster & Partner for the time period of late December 1997. Miss Strohmenge is designated as "Ni" which is an abbreviation for her first name, Nicole, Examination of the calendar shows her absence on the days indicated in the previous paragraphs.

Annex E extends the calendar to 1998 substantiating the absence of Miss Strohmenge during the time period in question.

In conclusion, this communication provides sufficient reasonable evidence and argumentation to support the fact that, despite due care, the subject request for nationalization in the United States of the subject patent application was delayed. Request for reconsideration is hereby made.

Respectfully submitted

Dr. Paul Vincent

Registration Number 37,461

Agent for the Applicant

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D-70174 Stuttgart, Germany
Telephone +49-711-22 29 94 0
Fax +49-711-29 95 94

Enclosures:

Annexes A, B1, B2, C, D and E

### PATENTANWÄLTE SCHUSTER & PARTNER

ANNEX A

	ENDFRISTEN Stand: 18.12.1				
Frist Erl.7	RN	Mandant		beiter	
21.12.97	W 3190	Fröscher	Widerspruckserwiderung	Es	
_	<del>- yv 3090</del>	Wakol	evtl. Widerspruch	Ni	
•	W 3492 CT	Jauch	Anmeldegebühr + Vollmacht	Ni	
05.01.98		Schmidt-Hand	Stellungnahme zur Widerspruchsbegründung	Es	
05.01.98	W 3261	Marcus Fischer	Erinnening - Einlegen	Es	
06.01.98		Wakol	evtl. Widerspruch Interox ./. Intercoll	Es	
07.01.98	W 3249	Linder	Widerspruchserwiderung	Es	
08.01.98		Wylie	Nationale DE Phase einleiten	Ni	
09.01.98	W 1506 BR	TOX	evtl. Widerspruch ./. Abtox	Es	
10.01.98	W 2893	Schuster, R.	Erinnerungsbegründung	Es	
10.01.98	TW 2815	Wendler	Erteilungs- und Jahresgebühren	Ni	
11.01.98	iP 1854	Hohnecker	Prüfungsbescheid (1 x verlängert)	Vo	
11.01.98		Bärtle	Bescheidsäußerung	Vo	
12.01.98	P 2941 US	Lauk,	30 M. nationale Phase - USA eingeleitet ?	Vo	
12.01.98	W 3091 E 1		Benutzungsnachweis Truff	Ni	
12.01.98		Schuster /	Gerichtsgebäude Meldorf, 12 Uhr, Heide !!!	Ës	
15.01.98 🗀		Nerina	Impftermin Kinderlähmung	Es	
17.01,98	P 3238 DE	MEDISANA	Prio	Vo	
17.01.98	P 3422	Maja	Mängelbescheid	Ni	
	P 3378	Maja	Mängelbescheid	Ni	
17.01.98	P 3385	Maja	Mängelbescheid	Ni	
19.01.98 🗌		Reinh.	Rückmeldefrist + Zahlung Studiengebühren Reinh. Schuster	Es	
	P 3529	Hölzer	WV-Vo, da Präsentation geplant ist	Vo	
21.01.98	W 3328	Hilt	Widerspruchserwiderung + Bescheidserledigung (Wvz)	Es	
	CT 2124		Bescheidsäußerung	Es	
	W 3414 CT	Schuster, Erika	Prio	Ni	
	CT 2918	Wolf	Bescheidsäußerung	Es	
	W 2185	Duclas	Benutzung	Ni	
	PCT 2961	Hohnecker	30 M. nationale Phase	Vo	
30.01.98		Schwartz	Prio	Es	
	W 2200 JP	TOX	Benutzung	Ni	
	P 2782	Kühner	Regel 51(4)	Vo	
	W 3171	LBS	Widerspruchserwiderung	Es	
	P 3345 DE		Bescheidserledigung	Ni	
	P 3404		Priobeleg eingereicht? (P 3404 ist iP von Günders eigener Anmeldung)	Ni	
			Prio	Vo	
			Prio	Vo	
			Sequenzprotokol einreichen	Vo	
			Vorl. Prüfungsbericht	Ni	
			Vollmacht in Polen	Ni	
		Dr. Scholz	Legalized Power of Attorney in Paraguay	Ni	
		Lauk,	EP-Anmeldung eingeleitet + Gebühren gezahlt (31 Mon.)	Ni	
4991			Prio	Es	
			Regel 51(4)	Ni	
-J.VE.70 L	W 3427 CT	PIV	Prio	Ni	



Datum:

49 711 299594 3645161

Rechnungs Nr: 13.05.1999 1792-4762-3 Kunden Nr:

Seite 2

2

ANNEX B2

Diese Rechnung gilt in Verbindung mit der Durchschrift des Luttfrechtbriefes (den Durchschriften der Luttfrechtbriefe) [Air Waybille] als Ausfuhrnachweis für Umsatzsteuerzwecke aller oben aufgeführten Exportsendungen gemäß § 10 Abs. Nr.1 UStDV 1993 und Abschnitt 133 Abs.3 Satz 1 UStR. Die Beförderung der in den genannten Luftfrachtbriefen aufgeführten Gegenständen wurde gemäß der Versandanweisung des Versenders durchgeführt, Ich versichere, daß Ich die Angaben über die Versandung/Selörderung nach bestem Wissen und Gewissen aufgrund von Geschäftsunterlagen gemacht habe, die im Geltungsbereich der USIDV nachprüfbar sind. Antje Schütt-Fahrenkrog, Geschäfteführerin

Diese Beschelnigungsform und der maschinelle Unterschrifteausdruck wurde genohmigt durch Verfügung der Oberfinanzdirektion Frankfurt am Main vom 13.01.1995, Az: S 07134 B - FEDEX/87 • St IV20

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ANNEX C

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SCHUSTER & PARTNER

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S geeund"-Karriere. Ur Sitzberufe erhalten IR-Geschäftestellen.

ANNEX D

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Hossen	<b>-</b> 2	24.03,-12.04.		24, 0705, 09.	20.10,-25,10,	122, 12, -08, 01, 92
Mecklenburg-Vorgommenn	03.02,-12.02.	22, 03,-01, 04,	16,05,20,05.	28,08,-06.08.	04, 10,-14, 10,	22, 12,-02, 01, 98
Niedersscheen	<b>≐</b> 1 s.4. +i +	24, 0312.04.	09. 05. u. 20. 05.	17.0727.08.	20, 10,-01, 11,	22. 1206. 01. 98
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Schleswig-Holstein	<b>=</b>	21. 0307. 04.	-	18,08,-02,08.	06, 1018, 10.	22. 1206. 01. 9
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### DIE BARMER

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## ANNEX E

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